

### REMARKS

Claims 53, 63, and 64 are pending. Claim 53 is amended to correct an unnecessary duplication in the definition of "Q" and to add the word "or" in the same definition.

Claims 53, 63, and 64 stand rejected for allegedly being unpatentable under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 5,773,571 ("the 571 patent"). Applicants traverse because the instant claims are patentable distinct from claim 1 of the 571 patent.

In determining whether a nonstatutory basis exists for a double patenting rejection, the issue is whether any claim in the application defines an invention that is merely an obvious variation of an invention claimed in the patent. When the claimed subject matter is patentably distinct from the subject matter claimed in a commonly owned patent, a double patenting rejection is improper. *Eli Lilly & Co. v. Barr Labs., Inc.*, 58 U.S.P.Q.2d 1865 (Fed. Cir. 2001). Any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination (*In re Braat*, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991)); however, a double patenting rejection must rely on a comparison of only the claims. MPEP § 804, part III.

The instant claims are patently distinct from claim 1 of the 571 patent. To arrive at any claimed invention, much picking and choosing from the many options in claim 1 of the 571 patent is required. For example, claim 1 of the 571 patent has numerous possibilities for the selection of  $L^1$ - $L^n$ , whereas in the instant claims, this variable is a naturally occurring nucleobase. The 571 patent also presents numerous possibilities for  $R^6$  and  $R^7$ . In the instant claims,  $R^6$  and  $R^7$  are H. In the instant claims, "y" is 1 and "z" is 2, while claim 1 of the 571 patent allows that "each of y and z is zero or an integer from 1 to 10, the sum of y+z being greater than 2 but not more than 10." In addition, the instant claims state that each pair of A- $A^m$  and B- $B^m$  is  $>N-C(O)-CH_2-$ , while there are a vast number of possibilities for the equivalent  $A^1$ - $A^n$  and  $J^1$ - $J^n$  combinations in claim 1 of the 571 patent. Such picking and choosing, without any apparent motivation, is inconsistent with obviousness. As such, the rejection is improper and the rejection should be withdrawn.

Claims 53, 63, and 64 stand rejected for allegedly being unpatentable under the judicially created doctrine of obviousness-type double patenting over claims 1, 4, 5, and 7 of

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PATENT  
REPLY FILED UNDER EXPEDITED  
PROCEDURE PURSUANT TO  
37 CFR § 1.116

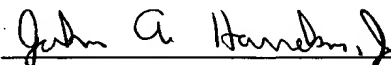
U.S. Patent No. 6,395,474. As previously agreed to, Applicants are prepared to submit a terminal disclaimer with respect to this patent in due course. It is believed that this submission will render the rejection moot.

Claims 53 and 63 stand rejected for allegedly being unpatentable under the judicially created doctrine of obviousness-type double patenting over claims 1 and 12 of U.S. Patent No. 6,613,873 ("the 873 patent"). Applicants traverse. As is the case with the 571 patent, the amount of picking and choosing from the teachings of claims 1 and 12 of the 873 patent that would be required is inconsistent with obviousness. In the instant claims, L is a naturally occurring nucleobase while the 873 patent allows that L can also be non-naturally occurring nucleobases. In addition, the 873 patent states that at least one L be a 2,6-diaminopurine nucleobase. Claims 1 and 12 of the 873 patent also allow that R<sup>7'</sup> is H or C<sub>1</sub>-C<sub>8</sub> alkylamine. In the instant claims, the variables R<sub>6</sub> and R<sub>7</sub> are H. Applicants submit that these differences are significant, and that the instant claims are not obvious in view of the cited art. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection.

In view of the foregoing, Applicants respectfully submit that the claims are in condition for allowance. An early notice of the same is earnestly solicited. The Examiner is invited to contact Applicants' undersigned representative at (215) 564-8366 if there are any questions regarding Applicants' claimed invention.

Respectfully submitted,

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